



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,792	01/26/2004	Kenneth C. Johnson	TWI-33010	9766

28584 7590 01/13/2006

STALLMAN & POLLOCK LLP
353 SACRAMENTO STREET
SUITE 2200
SAN FRANCISCO, CA 94111

EXAMINER

WACHSMAN, HAL D

ART UNIT	PAPER NUMBER
----------	--------------

2857

DATE MAILED: 01/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/764,792

Applicant(s)

JOHNSON, KENNETH C.

Examiner

Hal D. Wachsman

Art Unit

2857

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-6 and 15-18 is/are allowed.
- 6) ☒ Claim(s) 7-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. The replacement Abstract in the reply filed 11-10-05 is objected to under 37 C.F.R. 1.72 because any new or replacement abstract must be submitted on a separate sheet. Appropriate correction is required.
2. Paragraph 3 of the prior Office action noted that the listing of references in the specification is not a proper information disclosure statement. However, there were no comments on this in the Remarks/Arguments section of the reply filed 11-10-05. Appropriate explanation is required.
3. Page 10, line 7, of the specification refers to U.S application serial no. 10/611,298 but does not provide the current status of this application. Appropriate correction is required.
4. Claims 1-18 are objected to under 37 C.F.R. 1.75(a) for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. Claim 1, step b, cites "interpolating based on the pre-computed optical response..." however interpolating what exactly based on the pre-computed optical response is being referred to here ? This same type of problem also occurs in claim 7, lines 10-11, claim 11, line 10, and claim 15, lines 7-8. The last line of claim 7 cites "and determining the measurement parameters therefrom" however was this intended to be "and generating the measurement parameters therefrom" ? Claim 10, line 2, cites "database interpolation" and "iterative evaluation operations" both of which lack antecedent basis. Claim 10, lines 2-3, cite "...are invoke in sequence.." which appears should be "...are invoked in sequence..". Claim 11, line 5, cites "the resulting output field" which lacks antecedent basis. Claim 11, line 11, cites "obtained from the database"

Art Unit: 2857

which appears should be "located in the database". Claim 15, lines 8-9, cite "... and; and" (i.e. only one "and" is needed here). The examiner asks the applicant to better claim the limitations cited above. While the examiner understands the intentions of the applicant he feels confusion could be drawn from the limitations cited above.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

6. Claims 7-13 are rejected under 35 U.S.C. 102(a) as being anticipated by Sezginer et al. (WO 02/065545 A2).

As per claim 7, Sezginer et al. (Abstract, page 3 lines 27-29) disclose "a measurement system for illuminating the sample...to determine an optical response of the sample" and "a processor for generating measurement parameters that correspond to the measured optical response, the processor configured...". Sezginer et al. (figure 20, page 43 lines 28-31) disclose "a database searching module for searching a database to locate a pre-computed optical response". Sezginer et al. (figure 20, page 31, lines 22-35, page 32 lines 1-4, page 44, lines 1-4) disclose "a interpolated refinement module...to generate an interpolated optical response that more closely

Art Unit: 2857

matches the determined optical response". Sezginer et al. (Abstract, figure 19, page 9 lines 4-11, page 25 lines 4-7, page 31 lines 10-34, page 34 lines 18-22, page 40 lines 17-30) disclose "a theoretical refinement module for iteratively refining the interpolated optical response and determining the measurement parameters therefrom".

As per claim 8, Sezginer et al. (Abstract, figure 19, page 9 lines 4-11, page 25, lines 4-7, page 31 lines 10-34, page 34 lines 18-22, page 40 lines 17-30) disclose the feature of this claim.

As per claim 9, Sezginer et al. (figure 20, page 32 lines 1-4, page 44, lines 1-4) disclose the feature of this claim.

As per claim 10, Sezginer et al. (Abstract, figures 19, 20, page 9 lines 4-11, page 25 lines 4-7, page 31 lines 10-34, page 32, lines 1-4, page 34 lines 18-22, page 40 lines 17-30, page 43 lines 28-31, page 44 lines 1-4) disclose the feature of this claim.

As per claim 11, Sezginer et al. (Abstract, page 3, lines 27-29) disclose "illuminating the sample with an incident field" and "measuring the resulting output field to determine a measured optical response of the sample". Sezginer et al. (figure 20, page 43 lines 28-31) disclose "searching within a database of pre-computed optical responses...to locate the pre-computed optical response that most closely matches the measured optical response". Sezginer et al. (figure 20, page 31, lines 22-35, page 32 lines 1-4, page 44, lines 1-4) disclose "interpolating to refine the pre-computed optical responseto more closely match the measured optical response". Sezginer et al. (Abstract, figure 19, page 9 lines 4-11, page 25 lines 4-7, page 31 lines 10-34, page 34

lines 18-22, page 40 lines 17-30) disclose "iteratively evaluating a theoretical model to refine...to more closely match the measured optical response".

As per claim 12, Sezginer et al. (Abstract, figure 19, page 9 lines 4-11, page 25, lines 4-7, page 31 lines 10-34, page 34 lines 18-22, page 40 lines 17-30) disclose the feature of this claim.

As per claim 13, Sezginer et al. (figure 20, page 32 lines 1-4, page 44, lines 1-4) disclose the feature of this claim.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sezginer et al. (WO 02/065545 A2) in view of Johnson et al. (US 2002/0038196 A1).

As per claim 14, Johnson et al. (paragraphs 0088-0097) teach the feature of this claim. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply the techniques of Johnson et al. to the invention of Sezginer et al. as specified above because as taught by Johnson et al. (paragraph 0088) improved interpolation accuracy can be obtained by using a multi-cubic, rather than multilinear, interpolating function in each grid cell.

9. Claims 1-6 and 15-18 are allowed subject to the appropriate correction of the 37 C.F.R. 1.75(a) objections cited in paragraph 4 above.

10. Applicant's arguments filed 11-10-05 have been fully considered but they are not persuasive with respect to the claims rejected above. On page 9 of the reply filed 11-10-05 the Applicant argues that "Claim 7 recites similar elements that also are not anticipated or rendered obvious by Sezginer". However, review of amended claim 7 compared to amended claim 1 clearly shows that claims 1 and 7 are not of the same scope and that there are some differences in the elements of these claims. Also, the Applicant's amendment to claim 11 to overcome the 35 U.S.C. 112 2nd paragraph problem identified in paragraph 5 of the prior Office action in which there was confusion with respect to what exactly constituted the scope of claim 11 for examination, necessitated the new grounds of rejection now being applied to claim 11 and the claims that depend from claim 11.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

Art Unit: 2857

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hal D. Wachsman whose telephone number is 571-272-2225. The examiner can normally be reached on Monday to Friday 7:00 A.M. to 4:30 P.M..

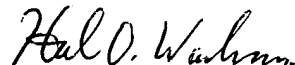
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marc Hoff can be reached on 571-272-2216. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

Art Unit: 2857

For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Hal D Wachsman
Primary Examiner
Art Unit 2857

HW
January 11, 2006



UNITED STATES DEPARTMENT OF COMMERCE

U.S. Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

SK

APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
---------------------------------	-------------	---	---------------------

10/764 792

EXAMINER

ART UNIT	PAPER
----------	-------

01102006

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

Hal D Wachsman
Primary Examiner
Art Unit: 2857